APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,490	07/26/2001	Michael Wayne Brown	AUS920010396US1	6710

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EXAMINER
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ART UNIT	PAPER NUMBER
2157	

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

		Application No.	Applicant(s)
Office Action Summary		09/915,490	BROWN ET AL.
		Examiner	**Art Unit**	
		Avi Gold	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 July 2001</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-56</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-56</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>7/26/01</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

This action is responsive to the application filed July 26, 2001. Claims 1-56 are

pending. Claims 1-56 represent watermarking messaging sessions.

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1-5, 8-16, 19-27, and 30-56 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Cotten, U.S. Patent No. 6,330,590 further in view of Zhao, U.S.

Patent No. 6,754,822.

Cotten teaches the invention substantially as claimed including the elimination of

unwanted bulk e-mail messages from delivery to specified e-mail addresses (see

abstract).

As to claim 1, Cotten teaches a method for recording a messaging session, said

method comprising the steps of:

applying a distinguishable watermark to a plurality of message entries within a

messaging session (col. 2, lines 28-30, Cotten discloses a numerical signature

identification code established for a bulk message); and

recording said plurality of messaging entries with said distinguishable watermark

applied, such that an origin of said plurality of message entries traceable according to

said distinguishable watermark (col. 2, lines 41-47, Cotton discloses each signature

being sent to a storage database comparator).

Cotten fails to teach the limitation further including the actual use of a watermark

on a message entry.

However, Zhao teaches techniques for protecting the security of digital

representations and of analog forms produced from them (see abstract). Zhao teaches

the use of a watermark added to digital representation to indicate ownership (col. 1,

lines 47-51, col. 2, lines 12-19, lines 55-60).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify Cotton in view of Zhao to use a distinguishable watermark on a

message. One would be motivated to do so because a watermark allows a message

entry to be traceable.

Regarding claim 2, Cotten teaches the method for recording a messaging

session according to claim 1, said method further comprising the step of:

applying said distinguishable watermark and recording said plurality of

messaging entries at a messaging server system communicatively connected via a

network to a plurality of client systems accessible to a plurality of users (col. 2, lines 18-

33, Cotton discloses a signature being established at a central server location in the

Internet).

Regarding claim 3, Cotten teaches the method for recording a messaging session according to claim 1, said method further comprising the step of:

applying said distinguishable watermark and recording said plurality of messaging entries at a separate one of a plurality of client systems communicatively connected via a network to said plurality of client systems accessible to a plurality of users (col. 2, lines 18-21, Cotton discloses installation at separate subscriber sites).

Regarding claim 4, Cotten teaches the method for recording a messaging session according to claim 1, said method further comprising the step of:

applying a plurality of distinguishable watermarks, each associated with a separate one of a plurality of users, to said plurality of message entries within a messaging session (col. 2, lines 28-30).

Regarding claim 5, Cotten teaches the method for recording a messaging session according to claim 1, said step of applying a distinguishable watermark further comprising the step of:

applying a textual watermark to said plurality of message entries within said messaging session (col. 2, lines 28-30).

Regarding claim 8, Cotten teaches the method for recording a messaging session according to claim 1, said method further comprising the step of:

transmitting said recording of said plurality of messaging entries with a plurality of watermarks applied to said plurality of users, wherein each of said plurality of watermarks corresponds to one from among a plurality of users participating in said messaging session (col. 3, lines 55-58, Cotton discloses the Central Server supplying signatures to the user).

Regarding claim 9, Cotten teaches the method for recording a messaging session according to claim 1, said method further comprising the step of:

storing said recording in a log file repository for tracing said origin of said plurality of message entries according to said distinguishable watermark (col. 3, lines 25-31, Cotton discloses a SPAM Detector Station storing the signature identification codes).

Regarding claim 10, Cotten teaches the method for recording a messaging session according to claim 1, said method further comprising the step of:

tracing a separate one of said plurality of message entries of said messaging session by comparing said separate one of said plurality of message entries with a plurality of watermarked recordings stored according to messaging session (col. 3, lines 31-36, Cotton discloses messages compared to signatures at the Comparator Rejection Station).

Regarding claim 11, Cotten teaches the method for recording a messaging session according to claim 1, said method further comprising the step of:

tracing a separate one of said plurality of message entries a separate one of a plurality of users by comparing said separate one of said plurality of entries with a plurality of watermarked recordings stored according to said plurality users (col. 3, lines 31-36).

Regarding claim 12, Cotten teaches the method for recording a messaging session according to claim 1, said method further comprising the step of:

applying said distinguishable watermark in response to a user request to record said plurality of messaging entries with watermarking (col. 3, lines 40-42, Cotton discloses SPAM being removed only from subscribers requesting the service).

Regarding claim 13, Cotten teaches the method for recording a messaging session according to claim 1, said method further comprising the step of:

applying said distinguishable watermark to a plurality of message entries already recorded for said messaging session (col. 2, lines 28-30).

Regarding claim 36, Cotten teaches a method for participating in a messaging session, said method comprising the steps of:

participating in a messaging session by receiving a plurality of messaging entries from a plurality of users participating in said messaging session (col. 3, lines 21-28, Cotton discloses an e-mail flow path to an e-mail subscriber server); and

receiving a recording of said messaging session, wherein said plurality of message entries for said messaging session are watermarked, such that use of said recording of said messaging session is traceable according to a watermark (col. 3, lines 25-31).

Regarding claim 37, Cotten teaches the method for participating in a messaging session according to claim 36, said method further comprising the step of:

requesting recording of said messaging session with watermarking of said plurality of message entries (col. 3, lines 55-58).

Regarding claim 38, Cotten teaches the method for participating in a messaging session according to claim 36, said method further comprising the step of:

watermarking said recording of said messaging session (col. 3, lines 25-31).

Regarding claim 39, Cotten teaches the method for participating in a messaging session according to claim 36, said method further comprising the step of:

participating said messaging session by transmitting watermarked message entries for access by said plurality of users participating in said messaging session (col. 3, lines 31-36, Cotton discloses SPAM-free e-mail delivered to a subscriber's e-mail register).

Regarding claim 40, Cotten teaches the method for participating messaging session according to claim 36, said method further comprising the step of:

submitting a watermarked entry to be traced according to said watermarking (col. 3, lines 22-36).

Regarding claim 51, Cotten teaches a method for protecting received message entries, said method comprising the steps of:

receiving a message entry in association with a messaging session at a client messaging system (col. 2, lines 18-21, Cotton discloses a live e-mail flow at a subscriber site); and

applying a watermark to said message entry, such that an origin of said message entry is traceable to said client messaging system (col. 2, lines 28-30).

Regarding claim 54, Cotten teaches a method for protecting message transmissions, said method comprising the step of:

detecting a new message entry entered at a client messaging system (col. 2, lines 18-21); and

applying a watermark to said new message entry prior to transmission for distribution within a messaging session, such an origin of said new message entry is traceable to said client messaging system (col. 2, lines 28-30).

Claims 14-16, 19-27, 30-35, 41-50, 52, 53, 55, and 56 do not teach or define any new limitations above claims 1-5, 8-13, 36-40, 51, and 54 and therefore are rejected for similar reasons.

3.   Claims 6, 7, 17, 18, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cotten and Zhao further in view of Rodriguez et al., U.S. Patent No. 6,650,761.

Cotten teaches the invention substantially as claimed including the elimination of unwanted bulk e-mail messages from delivery to specified e-mail addresses (see abstract).

As to claims 6 and 7, Cotten teaches the method of claim 1.

Cotten fails to teach the limitation further including the use of a graphical and audible watermark.

However, Rodriguez teaches systems using such optical interfaces to control computers, and to navigate over or act as portals on networks (see abstract). Rodriguez teaches the use of an audio watermark (col. 44, lines 66-67) and a graphical watermark (col. 53, lines 51-58).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Cotten in view of Rodriguez to use a graphical and audible watermark. One would be motivated to do so because it would allow for different options of visible watermarking.

Claims 17, 18, 28, and 29 do not teach or define any new limitations above

claims 6 and 7 and therefore are rejected for similar reasons.

Conclusion

4.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

U.S. Pat. No. 6,606,393 to Xie et al.

U.S. Pat. No. 6,754,822 to Zhao

U.S. Pat. No. 6,356,935 to Gibbs

U.S. Pat. No. 6,357,006 to Pham et al.

U.S. Pat. No. 6,625,734 to Marvit et al.

U.S. Pat. No. 5,828,835 to Isfeld et al.

U.S. Pat. No. 6,564,322 to Jameson et al.

U.S. Pat. No. 4,569,015 to Dolev et al.

U.S. Pat. No. 6,760,443 to Lacy et al.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Avi Gold whose telephone number is 703-305-8762.

The examiner can normally be reached on M-F 8:00-5:30 (1st Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 703-308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Avi Gold

Patent Examiner

Art Unit 2157

AMG

SALEH NAJJAR
PRIMARY EXAMINER